

REMARKS/ARGUMENTS

Claims 1-4, 6-13 and 15-18 are currently pending in this application. Applicants have amended claims 1, 8-10, 17, and 18. Reconsideration and further examination are respectfully requested.

35 U.S.C. § 103

The Office Action rejected claims 1, 6-10 and 15-18 under 35 U.S.C. § 103(a) based on Park et al., U.S. Pat. No. 6,643,520 (“Park”) in view of Rhoads, U.S. Pat. No. 6,278,781 (“Rhoads”), and in further view of LaRosa, U.S. Pat. No. 6,628,965 (“LaRosa”), and in still further view of Saeijs et al., U.S. Pat. No. 6,556,590 (“Saeijs”). The Office Action rejected dependent claims 2 and 11 under 35 U.S.C. § 103(a) based on Park in view of Rhoads and in further view of LaRosa and in still further view of Saeijs and in even further view of Balachandran, U.S. Pat. No. 6,608,828 (“Balachandran”). The Office Action rejected dependent claims 3, 4, 12, and 13 under 35 U.S.C. § 103(a) based on Park in view of Rhoads and in further view of LaRosa and in still further view of Saeijs and in even further view of Guo et al., U.S. Pat. No. 6,389,034 (“Guo”).

Applicants have amended claim 1, for example, to read “...determining an energy value for a transmission from a first station to a second station based on preamble information received and processed at the first station...” Support for this limitation may be found in various places in the present Specification, including but not limited to paragraphs [0035] and [0036] of the Specification.

Park fails to disclose or suggest determining an energy value for a transmission “based on preamble information received and processed” at a first station, i.e. the station not including the decoder. The Park reference discloses a power measurer 351, illustrated in FIG. 4 and described at col. 4, l. 49 through col. 5, l. 6. The power measurer 351 disclosed in Park fails to determine an energy value based on anything but the entirety of the data received; see, for example, the Rx signal” at the left side of FIG. 4 and accompanying text. Thus none of the text in Park determines an energy value based on preamble information received and processed as claimed.

Similar amendments have been made to independent claims 8-10, 17, and 18. Park does not disclose or suggest these limitations, and none of the other cited references, alone or in combination, disclose a design conforming to these claims, and these claims are not obvious based in part on Park.

With respect to the other references, the Office Action acknowledges that energy values are not shown by Rhoads, but cites Rhoads for the “determining an energy value” limitation of the claims. Rhoads discloses methods and systems for reducing theft of wireless telephony services. Rhoads, Abstract. In particular, Rhoads discloses coding a message to determine whether the message is received correctly. Rhoads, col. 12, ll. 6-27. Rhoads is directed to determining whether a call is fraudulent. In contrast, the present claims are directed to improving the performance of a decoder using energy values. Rhoads does not mention anything about energy values or using energy values to improve the performance of decoders.

Further, Rhoads discloses a telephone that randomly generates a number between 1 and 256, which serves as an index to these stored messages. Rhoads, col. 12, ll. 8-10. Applicants have amended the claims to recite determining an energy value includes locating the energy value in a look-up table and selecting an index value representing the energy value. In Rhoads, the index is a random number representing nothing, and certainly not energy values. For this further reason, the claims are not obvious based on the cited combination.

For at least the foregoing reasons, independent claims 1, 8-10, 17, and 18 are not obvious based on Park, Rhoads, LaRosa, and/or Saeijs, alone or in combination.

Alleged “Well Known” Concepts

Applicants again note that certain references are cited for the proposition of not what they show, but what they “might” show or that it would have been obvious to extend the disclosures to include some aspect or design feature not present in the references themselves. Such “filling in” of references is improper and constitutes reliance on general knowledge of the Examiner, which is improper. MPEP 2144.03 (“If the applicant traverses [] an assertion [that a concept is ‘well known’ or ‘matters of common knowledge’] the examiner should cite a reference in

support of his or her position.”). Applicants specifically point to, for example, the statements: “it would have been obvious to one of ordinary skill in the art to pick any of these ratios...” (Office Action, p. 4); equating of the Rhoads telephone message random numbering to the present claims (Office Action, p. 5); “it would have been obvious to one of ordinary skill in the art to use a look-up table instead of the ROM to meet the design requirements of the system.” (Office Action, p. 5). What “design requirements?” The Office Action is again simply filling in huge gaps in the cited references with unsubstantiated guesswork, which is entirely improper.

As a result, Applicants expressly ask for evidence in the form of references, affidavits or declarations showing all positions stated in the Office Action to be “ordinary skill in the art” or matters of common knowledge, or “known,” or the like, including but not limited to the statements of purported knowledge identified above.

Combination of References

With respect to combining references, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1101, 1017 (CCPA 1967). .

Here, the Examiner does not cogently explain how to modify the Park forward link transmission design with the Rhoads random number message indexing, the LaRosa wireless management design, and the Saeijs MPEG transmission design, for example. Applicants submit that it is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *KSR Int’l.*, 550 U.S. at 418. The conclusion of obviousness appears born from the use of impermissible hindsight reconstruction in view of Applicants’ Specification.

“To support a conclusion that a claim is directed to obvious subject matter... an Examiner must present a “convincing line of reasoning” as to why one of ordinary skill in the art would have found the claimed invention to have been obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). When determining whether a rejection based on design choice is appropriate, the

Examiner must review the Specification and ascertain if the limitation in question is disclosed as serving any advantage or particular purpose, or whether it solves a stated problem. The Examiner also should explain the reasoning used to determine that the prior art would have performed equally as well as the claimed invention. These two steps help present a “convincing line of reasoning.” *Ex parte Clapp*, 227 USPQ at 973.

The Office Action presents no convincing line of reasoning for combining the references in the manner suggested other than various terse, conclusory (or inapposite) statements. For example, the deficiencies of Park are filled in with Rhoads “to achieve a higher level of security for the system.” Office Action, p. 5. Security is not part of these claims, nor is security discussed to any significant extent in the present application – “fast estimation of traffic-to-pilot ratios” is discussed in the present application. The Office Action simply picks and chooses elements from these references based on the language of the claims and raises inapposite “security” reasons in an effort to cobble the references together. The reasoning presented is tantamount to saying that the reason for combining reference A with reference B is because then you would have A and B, where A and B are claimed.

The motivation to combine Park and Rhoads with LaRosa is “to improve error correction and detection at the receiver.” Office Action, p. 6. This is not a motivation to combine – it is an after-the-fact conclusory statement used as justification for combining two unrelated references to invalidate the claims. Saeijs is tossed in “to improve the efficiency of communication,” again a justification and not a motivation. Office Action, p. 6.

Applicants submit that there is no reasoning supporting combining the cited references, including Park, Rhoads, LaRosa, and Saeijs, and the other cited references, and that it is only through the use of impermissible hindsight that the Applicants’ claims may be constructed from the reference and purported knowledge in the art. Such hindsight reconstruction of the invention is impermissible. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also*, *Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947).

The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075.

None of the references, alone or in combination, teaches the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Appellants' claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...", citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

Simply stating that the invention would have been obvious to a person of ordinary skill is also insufficient, for the assertion must be supported by clear and convincing evidence. *Panduit, supra*, 810 F.2d at 1568. The Office Action merely states that the invention would be obvious in light of the proposed combination, and did not provide clear and convincing evidence or reasoning to support this assertion.

The Examiner has failed to avoid the effects of hindsight reasoning in fashioning the combination of Park, Rhoads, LaRosa, and Saeijs, and for these further reasons, independent claims 1, 8-10, 18, and 19, as amended, are allowable. Claims depending from allowable claims 1, 8-10, 18, and 19, as amended, are also allowable as they include limitations missing from the cited references.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant believes that no fees are due in accordance with this Response beyond those included herewith. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 17-0026.

Respectfully submitted,



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